

## **REMARKS**

### ***I. Amendment to the Specification***

#### ***A. Typographical Errors in Specification***

The amendments to paragraphs on page 2, 6, 7, and 10 correct typographical errors as objected to by the Examiner. The corrections of these typographical errors do not add any new matter to the specification and made purely for accuracy and clarity of the application.

### ***II. Amendment to the Claims***

Upon entry of the foregoing amendment, Claims 1-13 are pending in the application. Of the pending claims, Claim 1 is independent. Claims 14 – 30, the method claims, have been withdrawn. Nonetheless, Applicant requests that they be allowed to remain in the application for possible prosecution later by divisional application.

### ***II. Rejections under 35 U.S.C. § 103***

Claim 1 has been amended as requested above and is thus now considered to be in condition for allowance. In the next to last line of Claim 1, a grammatical correction has been made to the claim, changing “fit” to –fitting. Also, throughout the claim it has been clarified that the structure of the claimed fireplace surround does not merely affect the “appearance” of the surround, but also the feel and total simulated effect. Thus, in some places “appearing” has been removed and in some places the term “and feel” has been inserted after “appearance.” It is believed that this change should adequately address Examiner’s concern that “matters relating to ornamentation only which have no mechanical function cannot be relied upon to patentably distinguish the claimed invention....” The material and form of the claimed invention certainly

provide more than a distinctive look, but also provide a tactile effect which cannot be confused with other materials, such as brick. No new matter is introduced by these amendments which find ample antecedent basis in the specification, for example, on page 6, first paragraph of the Detailed Description, it is stated that “System 11 uses several parts that are cast out of light weight concrete replicating the look, **feel** and color of natural or man made stone.” (*Emphasis added*). This amendment is made for clarity and accuracy and to more clearly claim that which the Applicant deems to be the invention.

Applicant respectfully disagrees with Examiner’s assessment of Altman relative to the present claims. As amended, Claim 1, the independent claim reads as follows:

A fireplace surround simulating dry-stacked stone, comprising:  
a first leg adapted to be disposed vertically on one side of a fireplace opening;  
a second leg adapted to be disposed vertically on an opposing side of the fireplace opening;  
a header adapted to be disposed horizontally over the fireplace opening;  
said first leg comprising a single molded piece of material, said single molded piece of material having a **face with the appearance and feel of a plurality of non-uniform, dry-stacked stones, an outer edge with an irregular shape** simulating the appearance and feel of dry-stacked stones, and a substantially flat back, said face and said back being opposing surfaces;  
said second leg comprising a single molded piece of material, **said single molded piece of material having a face with the appearance and feel of a plurality of non-uniform, dry-stacked stones, an outer edge with an irregular shape** simulating the appearance and feel of dry-stacked stones, and a substantially flat back, said face and said back being opposing surfaces;  
said header comprising a single molded piece of material, said single molded piece of material having a face with the **appearance and feel of a plurality of non-uniform, dry-stacked stones**, and having opposing outer edges with irregular shapes simulating the appearance and feel of dry-stacked stones, said header having a substantially flat back;  
said header having a substantially flat base surface and said first and second legs having substantially flat top surfaces such that when the **header is placed upon the top surfaces of the legs without grout between said header and said legs**, the assembly of the header and the legs fitting closely together and **simulating a unitary structure of dry-stacked stone**.

Essentially, the present invention is a fire-place surround formed of separate molded units which once assembled simulate in effectively all respects a unitary structure of individual dry-stacked stones. The structure formed as claimed has not only the look, but also the feel of actual stone slabs that have been painstakingly stacked one by one. By contrast, the fireplace surround disclosed by the Altman patent is made only to have the appearance of a brick fireplace surround. It will be noted that bricks are formed in molds to be essentially identical in size and shape to one another. Bricks are not “non-uniform” as are the dry-stacked stone shapes of the present device. Further, grouted brick is very unlike stone slabs in look and feel. Notably, as claimed, the new fireplace surround completely lacks grout; i.e., “the header is placed upon the top surfaces of the legs without grout between said header and said legs,” as well as simulating a “**unitary** structure of dry-stacked stone.” Altman does not pretend to try to achieve a fireplace surround that simulates a “unitary structure.” Rather, although formed in sections, the ultimate simulation of the Altman device is of individual, look-alike bricks grouted together. Thus, the claimed structure and that of Altman are entirely different. For example, Claim 1 of Altman specifies “each of said surround components being cast from a cement-based brick-simulating material to provide a plurality of brick-like shapes spaced apart by and defining grout receiving recesses therebetween, said recesses terminating in webs of said brick-simulating material....” Altman is strictly limited to a brick simulating material in the form of “webs.” The present invention has no such structure and does not even suggest such a structure. Moreover, Altman does not give any indication of a structure which simulates the feel of dry-stacked stone. Further, the legs or the Altman surround are not provided with “an outer edge with an irregular shape.” The edges of bricks have a regular, substantially straight shape, quite unlike the completely irregular shapes of stones.

Accordingly, the Applicant respectfully submits that Altman neither teaches nor suggests the particular combination of structural features in the present Claim 1. Thus, Claim 1, the independent claim, is submitted to be in condition for allowance over Altman.

Similarly, because the independent claim is allowable over Altman, the dependent claims, 4 – 7 and 9, 10 are also in condition for allowance as being neither taught nor suggested by the art and as featuring patentable limitations on an allowable base claim.

The Examiner has also rejected Claim Nos. 1, 4-7, and 9-10 under 35 U.S.C. §103 as being unpatentable over Altman (U.S. Pat. No. 4,727,698).

Claims 2, 3 and 11 – 13 have been rejected under section 103(a) over Altman and further in view of Petersen. Because claims 2, 3, and 11 – 13 depend from claim 1, the arguments above regarding Altman apply equally to these claims above. In that Claim 1 is considered to be in condition for allowance over Altman, claims 2, 3 and 11 – 13 are also submitted to be in condition for allowance as featuring patentable limitations on an allowable base claim. Claims 11 – 13 have been rejected over Altman in view of Petersen. The addition of Petersen does not overcome the shortcomings of Altman, as explained above. Similarly, Claim 8 is rejected over Altman in view of Richmond. Again, in view of the arguments above, Claim 8 is allowable over the art. The shortcomings of Altman, discussed above are not overcome by Richmond. Accordingly, Claim 8 is also in condition for allowance as featuring a patentable limitation on an allowable base claim, Claim 1.

***Conclusion***

Applicant respectfully submits that the revised independent claim, Claim 1, is allowable over the prior art of record, including the cited references. For similar reasons, and for the additional reasons set forth above, Applicant urge that the dependent claims are also allowable.

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment is respectfully requested.

Respectfully submitted,

/Grant D. Kang/

By: Grant D. Kang, Reg. No. 37,651  
Husch & Eppenger, LLC  
190 Carondelet Plaza  
St. Louis, MO 63105  
314-480-1640  
314-480-1505 FAX